

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAMUEL F. LIPRIE

Appeal No. 2002-0933
Application No. 09/325,944

ON BRIEF

Before ABRAMS, FRANKFORT, and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 15. Claims 16 through 21, the only other claims in the application, have been withdrawn from further

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cancer or other diseases, and more particularly to a treatment catheter or transport tube (24) having a specially designed connector hub (26) allowing a radioactive source or sources to be maneuvered from an afterloader in a non-sterile environment into a sterile environment associated with the patient without the occurrence of contamination. In addition, it is noted (specification, page 12) that the specially designed connector hub (26) and the socket portion of connector port (30) assure the correct fit and connection of the treatment lumen to the afterloader device and also directly communicate with the afterloader device after the connector hub is locked in place to insure that the connection between the treatment catheter and the afterloader is complete. More particularly, pages 16 and 17 of the specification indicate that when one or both of sensors (46) or (48) associated with switches (50, 52) are depressed and the transport tube (24) is firmly locked to the afterloader, a signal is sent to the controller electronics of the afterloader through wiring (54) to thereby allow movement of a drive member through

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representative of the subject matter on appeal and a copy of those claims can be found appended to appellant's brief.

The references of record relied upon by the examiner in rejecting the appealed claims are:

Rague et al. (Rague)	4,851,694	Jul. 25, 1989
Fischell et al. (Fischell)	5,605,530	Feb. 25, 1997

Claims 1 through 15 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as the invention.

Claims 1 through 15 also stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed

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Claims 1 through 7, 9, 14 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rague.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rague as applied to claim 1 above, and further in view of Fischell.

Claims 10 through 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rague.

Rather than reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the Final rejection (Paper No. 10, mailed January 16, 2001) and to the examiner's answer (Paper No. 15, mailed November 5, 2001) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 14, filed August 16, 2001) and reply brief (Paper No. 16, filed

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OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner.¹ As a consequence of our review, we have made the determinations which follow.

As a preliminary matter, we note that issues (1) and (2) presented by appellant on page 5 of the brief relate to objections made by the examiner during the prosecution of the present application. The first is an objection to the drawings under 37 CFR § 1.83(a) and the second is an objection to the specification under 37 CFR § 1.75(d)(1). However, those particular issues relate to petitionable subject matter under 37 CFR § 1.181 and are not appealable. Under 35 U.S.C. § 134 and 37 CFR § 1.191 appeals may be taken from the decision of the primary examiner to reject claims. This Board does not and is

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Examining Corps. See, for example, In re Hengehold, 440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971) and In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). Accordingly, we make no further comment regarding the objections made by the examiner.

We turn now to the examiner's rejection of claims 1 through 15 under 35 U.S.C. § 112, second paragraph, noting that the examiner has urged that the phrase "operatively associated with" in claims 1 and 9 on appeal is unclear and does not provide a positive structural relationship between the first end of the conduit and the output end of the drive member, thereby rendering independent claims 1 and 9, and the claims which depend therefrom, indefinite. On page 9 of the brief, appellant argues that the language of claims 1 and 9 is entirely clear, particularly when understood in the context of the specification's description of a known remote afterloader and deployment of the flexible drive member thereof through the

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We have reviewed the specification and drawings of the present application (particularly pages 1, 2 and 14-18 of the specification) and, based on that review, share appellant's opinion that one of ordinary skill in the art would find the language of claims 1 and 9 clear and definite. Accordingly, we will not sustain the rejection of claims 1 through 15 under 35 U.S.C. § 112, second paragraph.

The examiner's rejection of claims 1 through 15 under 35 U.S.C. § 112, first paragraph as being based on a specification that, as originally filed, fails to provide written descriptive support for the invention claimed, is premised on the examiner's view that the specification does not adequately describe the conduit of the afterloader in relation to the drive member thereof. Again, we share appellant's view that a review of the specification of the present application, particularly pages 1, 2 and 14 through 18, would provide one of ordinary skill in the art with a reasonably clear understanding of the

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over which appellant's invention is an improvement. Note, for example, the afterloader (26) of Rague, which includes a flexible drive member (40) carrying radiation sources (28) at its output end and a conduit (42) through which the flexible drive member is driven so as to allow the radiation sources (28) to pass from the afterloader into the transport tube (22) and subsequently into the applicator (14) for proper placement within a patient. It is clear from appellant's disclosure, and that of Rague, that the output end of the flexible drive member carrying the radiation sources, when in its stowed position within the afterloader, will be housed in a shielding safe similar to that seen in Rague at (46) located at a first end of the afterloader conduit, and that the first end of the conduit is, in this manner, "operatively associated with" the output portion of the drive member.

Since we are convinced that the disclosure as originally filed would have clearly conveyed to those skilled in the art that appellant had invented the subject matter claimed, the

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§ 112, first paragraph, for failing to comply with the written description requirement will not be sustained.²

We next look to the examiner's rejection of claims 1 through 7, 9, 14 and 15 under 35 U.S.C. § 102(b) as being anticipated by Rague. On page 9 of the brief, appellant has indicated with regard to independent claim 1 on appeal that Rague does not teach the locking member set forth in the claim. According to the examiner, Rague shows a locking member (37).

Our review of the Rague patent, particularly Figures 4 and 5, and the specification thereof beginning at column 6, line 46, *et seq.*, reveals that member (37) of connector (34) on transport

² In this instance, we note however that the examiner has correctly observed that 37 CFR § 1.75(d)(1) mandates that the claims must conform to the invention as set forth in the remainder of the specification and that the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertained by reference to the description. While

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tube (22) is a "male plug" having a projecting portion which is received in and accommodated by an opening in a female plug socket (41) of connector (36) provided on the wall of the housing of the afterloader (26). As urged by appellant, Rague does not at any point in the specification indicate that the male plug (37) and female socket provide a locking function or act as a locking member. We see no reason to assume that they do.

As indicated on page 18 of appellant's specification, and as shown in Figures 5 and 6, the locking device of the present application includes a sliding plate (58) fitting into horizontal guiding channels (44) located adjacent to the exit port of the afterloader. The sliding plate has an opening large enough to allow the tubing section of the transport tube (24) to pass, but not the hub (26) of the tube, thereby allowing the transport tube to be locked firmly to the afterloader after hub (26) has been connected to and substantially completely mated within connector port (30). There is nothing in Rague that corresponds to the

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principles of inherency, each and every element or limitation of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Since Rague clearly does not disclose each and every element of the system defined in appellant's claim 1 on appeal, it follows that we will not sustain the examiner's rejection of that claim under 35 U.S.C. § 102(b) as being anticipated by Rague.

Claims 2 through 7 depend either directly or indirectly from claim 1 and thus include all the limitations thereof. Therefore, the examiner's rejection of dependent claims 2 through 7 under 35 U.S.C. § 102(b) as being anticipated by Rague is also not sustained.

Regarding the rejection of claims 9, 14 and 15 under 35 U.S.C. § 102(b) as being anticipated by Rague, the examiner

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answer. Appellant urges that Rague (col. 6, lines 56-59) merely indicates that elements (78) and (80) are connected together to assure a continuous electrical supply to the unit, and thus those elements in the Rague patent do not constitute a "presence sensing mechanism" which provides an indication of connection upon substantially complete mating of the first and second mating surfaces, as required in independent claim 9 and its dependent claims. In appellant's view, Rague merely emphasizes a continuous supply of electrical power without qualification as to whether the connector is substantially completely mated.

We agree with appellant that elements (78) and (80) of Rague appear to be designed to provide a supply of electrical power to the unit without regard to whether the first and second mating surfaces of the connectors (34, 36) or (37, 41) are substantially completely mated or not. Claim 9 specifies that "upon substantially complete mating of the first and second mating surfaces, the presence sensing mechanism provides an indication

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to allow one or more of the radioactive sources (19) to pass into the transport tube and subsequently into the patient via catheter (10), but only after the transport tube (24) is positively affixed to the connector port (30), i.e., the hub (26) of transport tube (24) is substantially completely mated with and locked firmly in the connector port (30). No such indication or signal is provided in Rague, and the elements (78) and (80) of Rague have no such capability. Thus, the examiner's rejection of claim 9, and dependent claims 14 and 15, under 35 U.S.C. § 102(b) as being anticipated by Rague will not be sustained.

The next rejection for our review is that of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Rague in view of Fischell. According to the examiner, it would have been obvious to one of ordinary skill in the art to provide a tube in Rague, presumably tube (38), with a tapered opening as illustrated in Figure 4A of Fischell. Claim 8 is dependent from claim 1, and appellant points out (brief, page 11) that Fischell does not

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relied upon by the examiner, it follows that we will not sustain the examiner's rejection of dependent claim 8 under 35 U.S.C. § 103(a).

As for the examiner's rejection of claims 10 through 13 under 35 U.S.C. § 103(a) based on Rague alone, we find the examiner's reasoning to be fraught with speculation and conjecture, and to be based entirely on hindsight derived from appellant's own disclosure. Moreover, as should be apparent from our discussion *supra*, we share appellant's view that Rague has no teaching or suggestion of a "presence sensing mechanism" which provides an indication of a substantially complete mating of the first and second mating surface, as required in independent claim 9, from which claims 10 through 13 either directly or indirectly depend. Thus, we will not sustain the examiner's rejection of claims 10 through 13 under 35 U.S.C. § 103(a).

To summarize our decision, we note that a) the examiner's

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through 7, 9, 14 and 15 under 35 U.S.C. § 102(b) based on Rague
has not been sustained; d) the rejection of claim 8 under
35 U.S.C. § 103(a) as being unpatentable over Rague and Fischell
has not been sustained; and e) the rejection of claims 10 through
13 under 35 U.S.C. § 103(a) has not been sustained.

In light of the foregoing, the decision of the examiner is
REVERSED.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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HERBERT M. BEDINGFIELD
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06040